

AMENDMENT UNDER 37 C.F.R. § 1.116
U. S. Application No. 09/701,634

REMARKS

Claims 1-5 and 11-14 are all the claims pending in the application.

Applicant proposes to cancel claims 5 and 13 and amend claims 1 and 14 by the present Amendment.

Claims 1-5 and 11 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kato (JP 09-99444 A) in view of Logan et al. (US 4,711,035) and Wood et al. (US 5,053,971), and further in view of Blomberg et al. (US 6,242,065) or Applicant's Admitted Prior Art (AAPA). Claim 12 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kato in view of Logan et al., Wood et al., and Blomberg et al. or AAPA, and further in view of Komatsu et al. (JP 06-191159). Claim 13 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kato in view of Logan et al. and Wood et al., and further in view of newly-cited Friedman (US 6,159,397) or AAPA. Claim 14 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kato in view of Logan et al., Wood et al., and either Friedman or AAPA, and further in view of Elias et al. (US 4,915,986). Applicant respectfully traverses the rejections as set forth below.

Applicant submits that the applied references fail to teach or suggest the edging mark of the marking step claimed in claim 1. The Examiner refers to Logan et al. as allegedly disclosing this feature of the claim. The Examiner states (Office Action, pages 3-4) that

“Logan et al. teach that the optical industry generally produces a pattern having the size and shape of a lens opening in an eyeglass frame for use as a guide in an edge grinding and contouring apparatus to peripherally edge grind the optical lens to the size of the lens opening. The shape of the lens opening is transferred to the surface of the lens blank by tracing the outline of the inner periphery of the lens opening with a marker. The blank is then cut following the outline on the blank surface to form a pattern corresponding to the associated traced lens opening (Col. 1, lines 15-30). In other words, the edging outline taught by Logan et al. “functions as boundary” between the portion of the lens

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blank which forms the lens and the portion of the lens blank that is cut-off. Since the lens is cut following the outline of the blank surface, it would have been obvious to one of ordinary skill in the art to look at (i.e., inspect) the edging line in order to insure that the lens is cut to the appropriate size and shape (i.e., by following the edging outline) as desired by Logan et al. As such, the edging line of Logan et al. "functions as a boundary for appearance inspection" as required by the applicant's claims."

Applicant respectfully submits that the Examiner has misinterpreted Logan et al. First, the edging outline taught by Logan et al. is a cutting line, and following the edging outline taught by Logan et al., the lens blank is immediately cut-off. The edging outline taught by Logan et al. has only one use, i.e., as a cutting line, because the edging process is the last process of the lens manufacturing process. Therefore, it would be unexpected to use an edging mark for a use other than as a cutting line. Therefore, it would not have been obvious to one of ordinary skill in the art of eyeglass to use the edging outline as a boundary for appearance inspection.

Second, the edging outline taught by Logan et al. is a cutting line to be cut-off by edging. On the contrary, the edging mark of claim 1 of the present invention is not a cutting line. Rather, the edging mark of claim 1 indicates a first region of the lens remaining after an edging matched with an inner peripheral edge of openings of the spectacle frame and is positioned outside the first region of a surface of the spectacle lens in a second region, to be cut off by the edging, of a surface of the spectacle lens, and which functions as a boundary for appearance inspection. Thus, Logan et al. do not disclose or teach the edging mark of claim 1 of the present invention.

Since the remaining applied references fail to make up for the above-noted deficiencies of Logan et al., Applicant submits that claim 1 and its dependent claims 2-4, 11, 12, and 14 are allowable over the prior art.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Cameron W. Beddard
Registration No. 46,545

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE



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